

REMARKS

Claims 1-7 are pending in the application. Claims 1-7 stand rejected.

Claim 3 is objected to for an informality. Claim 3 has been amended herein as suggested by the examiner.

The title is objected to as not being descriptive. The Examiner has suggested a new title which is adapted and amended herein.

Claim 6 has been amended to clarify the claimed subject matter. The amendment is supported by applicant's original specification and claims, for example paragraph 29 of the specification. No new matter is entered.

In the Office Action claims 1-3 are rejected under 35 U.S.C. § 103(a) as unpatentable over Forslow (U.S. 6,973,057) in view of Bomar et al. (U.S. 6,535,738) (hereinafter Bomar).

Claim 4 is rejected as unpatentable over Forslow in view of Bomar and further in view of Suzuki (U.S. 6,791,946).

Claims 5-7 are likewise rejected as unpatentable over Forslow in view of Bomar with claim 5 further in view of Baiyor (U.S. 6,282,429), claim 6 further in view of Douglas (U.S. 6,487,596) and claim 7 is rejected as in claim 6 and further in view of Jennings (U.S. 6,597,774).

The combination of Forslow and Bomar are used in each claim rejection. Forslow describes a mobile access service using the home agent/foreign agent model and also describes a data tunnel. However, simply describes a system for optimizing the number of communication links used in soft hand-off.

In the Office Action col. 2, lines 9-13 of Bomar is referred to and asserted as providing motivation for combining Forslow and Bomar. Specifically the Office Action asserts that "by

reducing the number of simultaneous channels used in each soft handover (=handoff) of a mobile, it may increase the system handover capacity."

However, what is actually described in this portion of Bomar and suggested by Bomar is that "if the number of traffic channels reserved for use in soft handoffs is reduced, then the number of calls being dropped as a result of mobile-telephones traversing from one cell to another cell may increase due to traffic channels not being available for soft handoffs." (emphasis added).

What Bomar is suggesting that there needs to be an increase in the number of reserved traffic channels to keep the number of dropped calls from increasing, in contrast the Office Action is asserting that Bomar suggests reducing the number of simultaneous channels used in each soft handover.

Therefore, the motivation asserted in the Office Action is contradictory to the teachings in Bomar.

In Bomar's system, the mobile-telephone or mobile-station itself minimizes the number of the base stations in order to limit the number of channels.

In contrast applicant's claimed invention recites the communication device managing the mobile node controls the number of tunnels, not the mobile node (=mobile-telephone). Also Bomar wants to minimize the number of base stations in contrast applicant is not minimizing the number of data tunnels but concerted with the number of tunnels exceeding a predetermined threshold.

Therefore, applicant's claimed invention is different from Bomar.

It is respectfully requested the rejections be withdrawn because the MPEP 2143 requires to establish a *prima facie* case of obviousness, three basic criteria must be met.

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.

Second, there must be a reasonable expectation of success.

Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

This rejection fails on all three of the tests. First the Office Action purports to modify applicant's claimed invention to fit the cited references but the Office Action points out motivation which is contradictory to the teaching of the reference. Applicant respectfully submits there is no motivation and applicant's own disclosure is being used as a road map in order to make this rejection. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

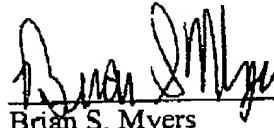
Second the references do not teach all the limitations as admitted in the Office Action. As pointed out above Bomar is different from the claimed invention.

Third there is no teaching anywhere that there would be a reasonable expectation of successfully modifying the teaching of the cited references in order to arrive at the proposed combination of references. Again only applicant's disclosure is being used to provide such a road map of success.

In view of the remarks set forth above, this application is in condition for allowance which action is respectfully requested. However, if for any reason the Examiner should consider this application not to be in condition for allowance, the Examiner is respectfully requested to telephone the undersigned attorney at the number listed below prior to issuing a further Action.

Any fee due with this paper may be charged to Deposit Account No. 50-1290.

Respectfully submitted,



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